

# Notice of Allowability

Application No.

10/092,243

Examiner

Mark L. Shibuya

Applicant(s)

HILLMAN, JEFFREY DANIEL

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## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Reply entered 6/16/2005.
2. ☒ The allowed claim(s) is/are 1-11.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

### Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

  
PADMASHRI PON  
PRIMARY EXAMINER

Mark L. Shibuya  
Examiner  
Art Unit: 1639

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### EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Dr. Lisa M.W. Hillman on September 16, 2005.

The application has been amended as follows:

In the Claims:

2. Claims 13-22 are canceled.

3. In claim 1, lines 3-5,

"adsorbing antibodies against antigens that are expressed by the microbe *in vivo*  
and *in vitro* with cells or cellular extracts of the microbe that have been  
grown *in vitro*;"

is *replaced* with the following:

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--adsorbing an antibody sample with cells or cellular extracts of the microbe that have been grown *in vitro*, wherein the antibody sample comprises antibodies specific for antigens expressed by the microbe when grown *in vivo* and antibodies specific for antigens expressed by the microbe when grown *in vitro*;--

4. In claim 1, line 7, "or RNA" is *deleted*.

5. In claim 1, line 11, "or RNA" is *deleted*.

#### **Reasons for Allowance**

The following is an examiner's statement of reasons for allowance:

6. The Oath or Declaration, entered 6/16/2005, is acknowledged.

7. Upon reconsideration, the examiner finds that the instant application is properly a continuation in part of Serial No. 09/980,845, filed 11/15/2001; which is the national stage of PCT/US00/21340, international filing date; which claims benefit of U.S. Provisional Application 60/147,551, filed 8/6/1999.

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8. Upon reconsideration, the examiner finds that the elected invention of Group I, drawn to methods of identifying a polynucleotide expressed *in vivo*, comprising probing a phage display library with absorbed antibodies, has descriptive and enabling support in PCT/US00/21340 and 60/147,551.

9. The rejection of Claims 1-12 under 35 U.S.C. 103(a) as being unpatentable over Progulske-Fox, WO 01/11081; Granoff et al., US 6,048,527; and Bargatze et al., US 2004/0247611, is therefore withdrawn.

10. The rejection of Claims 1-12 under 35 U.S.C. 103(a) as being unpatentable over Handfield et al., Trends In Microbiology, (July 2000), Vol. 8, No. 7, pp. 336-339; Granoff et al., US 6,048,527; and Bargatze et al., US 2004/0247611, is therefore withdrawn.

11. The rejection of Claims 1-12 under 35 U.S.C. 103(a) as being unpatentable over Hautefort et al., Phil. Trans. R. Soc. Lond. B, (2000) Vol. 355, pp. 601-611 (IDS entered 6/6/2002, reference No. 20), Granoff et al., US 6,048,527 and Bargatze et al., US 2004/0247611, is therefore withdrawn.

12. Applicant's arguments, see pp. 8-10, filed 6/16/2005, with respect to the scope of enablement for claims 1-7 and 9-12 have been fully considered and are persuasive. The rejection of Claims 1-7 and 9-12 under 35 U.S.C. 112, first paragraph, has been withdrawn.

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13. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Shibuya whose telephone number is (571) 272-0806. The examiner can normally be reached on M-F, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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